

REMARKS/ARGUMENTS

In response to the Final Office Action dated August 10, 2005, claims 11, 24, 25, 27 and 30 are amended. Claims 11, 12, 15, 16, 19 and 21-30 are now active in this application. No new matter has been added.

It should be noted that the amendments to claims 11, 24, 25, 27 and 30 correct spelling and/or improve form and do not change the scope of the claims.

REJECTION OF CLAIMS UNDER 35 U.S.C. § 103

Claims 15-14, 11-13, 7-9, 4-5, 19-20 and 22 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Tarr et al. (USPN 5,184,179) in view of RD 330036. However, the Examiner identification of rejected claims is incorrect as of the identified claims, only claims 11, 12, 15, 16, 19, 21 and 22 are pending in this application. In fact, claims 11, 12, 15, 16, 19 and 21-30 are pending in this application, but there is no actual rejection of claims 23-30. For purpose of this Office Action, it is presumed that the Examiner intended claims 11, 12, 15, 16, 19 and 21-30 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Tarr et al. (USPN 5,184,179) in view of RD 330036.

The rejections are respectfully traversed.

In imposing a rejection under 35 U.S.C. §103, the Examiner is charged with the initial burden of identifying a source in the applied prior art for: (1) claim limitations; and (2) the requisite motivation to combine references with a reasonable expectation of achieving a specific result. *Smiths Industries Medical Systems v. Vital Signs*, 183 F.3d 1347, 51 USPQ2d 1415 (Fed. Cir. 1999). That burden has not been discharged. Specifically, it is not apparent and the Examiner has not identified wherein Tarr et al. and/or RD discloses or suggests “a decision unit

for decision whether or not the command data received by the receiving unit includes the first expiration date and/or time”, recited in claim 25, “deciding whether or not the command data received the receiving unit includes the first expiration date and/or time”, recited in claim 29, and “...expiration date and/or time *in accordance with the kind of the command*”, recited in claims 27 and 30.

Legal precedent is well developed with respect to 35 U.S.C. § 103. As stated in *Graham v. John Deere Co.* 383 U.S. 1, 13, 148 USPQ 459, 465 (1966), obviousness under 35 U.S.C. § 103 must be determined by considering (1) the scope and content of the prior art; (2) ascertaining the differences between the prior art and the claims in issue; and (3) resolving the level of ordinary skill in the pertinent art. The PTO is thus charged with the initial burden of identifying a source in the applied prior art for: (1) claim features; and (2) the realistic requisite motivation for combining applied references to arrive at the claimed invention with a reasonable expectation of successfully achieving a specific benefit. *Smith Industries Medical Systems v. Vital Signs*, 183 F.3d 1347, 51 USPQ2d 1415 (Fed. Cir. 1999). This burden is not met if there is no showing that the combination of references would actually meet all the limitations of the claims under consideration.

An Office Action rejection must provide a reason why one having ordinary skill in the art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 227 USPQ 657 (Fed. Cir. 1985); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); *In re Warner*, 379 F.2d 1011, 154 USPQ 173 (CCPA 1967). The Examiner should recognize that even if the prior art *could* be modified so as to result in the combination defined by the claims

the modification would not have been obvious unless the prior art suggested the desirability of the modification. *In re Deminski*, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986). In the absence of such a prior art suggestion for modification of the references, the basis of the rejection is no more than inappropriate hindsight reconstruction using appellant's claims as a guide. *In re Warner*, 379 F.2d 1011, 154 USPQ 173 (CCPA 1967).

What may or may not be known in general does not establish the requisite realistic motivation to support the ultimate legal conclusion of obviousness under 35 U.S.C. § 103. *In re Deuel*, 51 F.3d 1552, 34 USPQ2d 1210 (Fed. Cir. 1995). The requisite motivation is not an abstract concept, but must stem from the applied prior art as a whole and have realistically impelled one having ordinary skill in the art, at the time the invention was made, to modify a reference in a specific manner to arrive at a specifically claimed invention with a reasonable expectation of achieving a specific benefit. *In re Newell*, 891 F.2d 899, 13 USPQ2d 1248 (Fed. Cir. 1989).

The question is not what one having ordinary skill in the art could or could not do, but: *why* would one having ordinary skill in the art have been realistically impelled to deviate from the express teachings of the prior art to arrive at the claimed invention? *Gentry Gallery v. Berkline*, 134 F.3d 1473, 45 USPQ2d 1498 (Fed. Cir. 1998); *In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992).

It is submitted that the rationale stated in the Office Action for concluding obviousness is not sufficient to meet the above legal criteria. In the Office Action, the Examiner asserts that “a threshold value storing unit for holding threshold value information deciding a period for which the apparatus management data is valid”, will be interpreted as meaning, a value used for deciding when a condition is met associated with said value. However, such interpretation is, on

its face, not specific enough as, for example, claim 15 requires that the “threshold value information” be information for *deciding a period*. In this regard, it is clear that “period” is a “time period”. Thus, the threshold value information is information regarding *a time period in which the apparatus management data* that is included in the packet sent from the centralized management device to the apparatus connected to a respective apparatus management device *is valid*. This is entirely consistent with what is claimed and with the disclosure at page 22, lines 15+ under the section labeled Remote Command Processing. The Examiner’s interpretation “a value used for deciding when a condition is met associated with said value” is much broader than what is claimed.

As noted in the previous Response, Tarr et al. discloses that the computer control 16 (which corresponds to the control device) sends a signal to the billing computer 38 (which corresponds to the centralized management device) when the predetermined time period has ended (see column 6, lines 39-54). That is, when each predetermined time period ends, as measured using real time clock 30 and the predetermined time period store in RAM, the CPU 24 of the monitoring system sends a signal to the billing computer 38 indicating the end of the time period and then also forwards the total count value to the billing computer (to prepare a bill).

It is clear that the Examiner completely disregards the fact that Tarr et al. does not disclose a packet (including apparatus management data) sent from the billing computer (centralized management device) to the computer control 16 (corresponding to the apparatus connected to a respective apparatus management device), let alone determining that the apparatus management data in the packet was received during a time period in which such data is valid (see claim 15).

The Examiner does note that Tarr et al. “does not explicitly teach where said packets include expiration information (e.g. data and time) upon which validity of data is determined”. However, as noted above, Tarr et al. does not disclose a packet (including apparatus management data) sent from the billing computer (centralized management device) to the computer control 16 (corresponding to the apparatus connected to a respective apparatus management device).

The Examiner relies upon RD as teaching a method relating to transmission of mail items, including sending out a mail item including: time setting means for setting expiration date and time in a mail item for transmission, analyzing means for determining when the mail item has expired performing a predetermined action based on the outcome of the determination including send a notice to the sender indicating the mail item is returned from the recipient due to expiration data/time.

Finally, the Examiner contends “it would have been obvious to one of ordinary skill in the art at the time the invention was made given the disclosure for triggering data transmission via the network on a time event basis including the transmission of status and billing information. From the teachings of RD it would be readily apparent to one ordinary skilled that the evaluation of an expiration date/time entails comparing the current date/time with a given expiration date/time, and determining if said date/time has or not expired, configuring a mail application to perform several actions upon said evaluation and execute said actions based on the outcome. One ordinary skilled would be motivated to apply RD’s teachings to the Tarr system for receiving an notice when the mail item containing status/billing information has not been further processed or the contents become past due, enabling the sender to take subsequent actions, for example retransmission of said data if before a billing cycle deadline an alternate form of retransmission in response to said notice or discarding said data is received after said billing

cycle. One ordinary skilled in the art would further be motivated to apply the teachings of RD to any intermediate point between sender and destination, e.g. a mail server or relay device with mail application processing capabilities inhibiting the transmission of when the mail contents has become past due, i.e. “expired”, or the items content becomes sensitive due to future change (i.e. “future time related sensitive”) improving the bandwidth/resource utilization.”

The Examiner is requested to clarify what he intends by “it would have bee obvious to one of ordinary skill in the art at the time the invention was made *given the disclosure for triggering data transmission via the network on a time event basis including the transmission of status and billing information*”, as the sentence is incomplete.

The Examiner’s assertion that “One ordinary skilled would be motivated to apply RD’s teachings to the Tarr system for receiving an notice when the mail item containing status/billing information has not been further processed or the contents become past due, enabling the sender to take subsequent actions, for example retransmission of said data if before a billing cycle deadline an alternate form of retransmission in response to said notice or discarding said data is received after said billing cycle” does not take into consideration that in Tarr et al., the signal (notice) merely indicates the end of the predetermined time period and is always processed by the billing computer 38 when it is received and the billing computer 38 receives the total count value that is forwarded also. In reality, the Examiner has yet to provide a realistic reason why the signal indicated the end of the predetermine time period would ever realistically include an indication of when such signal expires.

Applicant stresses that the requisite motivation to support an obviousness conclusion is not an abstract concept, but must stem from the prior art as a whole to impel one having ordinary skill in the art to modify a reference or combine references with a reasonable expectation of successfully

achieving some particular realistic objective. See, for example, *In re Gyurik*, 596 F.2d 1012, 201 USPQ 552 (CCPA 1979). Consistent legal precedent admonishes against the indiscriminate combination of prior art references. *Carella v. Starlight Archery*, 804 F.2d 135, 231 USPQ 644 (Fed. Cir. 1986); *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 227 USPQ 657 (Fed. Cir. 1985); *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 221 USPQ 929 (Fed. Cir. 1984); *In re Ehrreich*, 590 F.2d 902, 200 USPQ 504 (CCPA 1979).

It is Applicant's position that the Examiner has not articulated any logical reason why one having ordinary skill in the art would have been motivated to modify Tarr et al. in view of RD. In this regard, it should be appreciated that Tarr et al. does NOT ever realistically encounter a situation where the signal sent to the billing computer 38 indicating the end of the predetermined time period is invalid, or that there is ever a determination/condition that such signal (indicating the end of the predetermined time period) can be sent to the billing computer 38 (to indicate the end of the predetermine time period) when the current date and/or time from real time clock 30 is not past the predetermined time period. More specifically, there is no realistic situation in which the signal sent to the billing computer 38 indicating the end of the predetermined time period would be invalid, as it is only sent after the predetermined time period has expired. Also, even if it were presumed that the arrangement of Tarr et al. could somehow send the signal (indicating the end of the predetermined time period) to the billing computer during a period when the current date and/or time from real time clock 30 is not past the predetermined time period, such signal (indicating the end of the predetermined time period) would be in error (invalid) since the predetermined time period has not ended.

Applicant maintains that a person of ordinary skill in the art would understand and appreciate that there is no condition in Tarr et al. where the signal indicating the end of the

predetermined time period would be generated when the predetermined time period has **NOT** ended, or that after the predetermined time period has past, a notice is sent to the billing computer that indicates the signal indicating the end of the predetermined time period is invalid. In this regard, the signal indicating the end of the predetermined time period is sent when the time generated by real time clock 30 equals the predetermined time period (see column 6, lines 42-46). There is no realistic situation where such signal would ever be considered invalid based upon it being past the predetermined time period, as it is merely a signal indicating the end of the predetermine time period.. It s noted also that in RD, since the mail involves the expiration date and time, the receipt (which corresponds to the control device) does **NOT** comprise the threshold information.

Thus, it is not apparent whence stems the requisite realistic motivation for one having ordinary skill in the art to zero in on the mail items of RD and then insert it into the system of Tarr et al. “for receiving an notice when the mail item containing status/billing information has not been further processed or contents become past due”, as Tarr et al. does **NOT** ever realistically encounter a situation where the signal sent to the billing computer 38 indicating the end of the predetermined time period is invalid. Clearly, the only apparent motivation of record for the proposed modification of the system disclosed by Tarr et al. to arrive at the claimed inventions is found in Applicant's disclosure which, of course, may not properly be relied upon to support the ultimate legal conclusion of obviousness under 35 U.S.C. §103. *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 227 1 USPQ2d 1593 (Fed. Cir. 1987).

It is, therefore, respectfully submitted that the Examiner has not established the requisite motivation for the proposed combination of references to arrive at the claimed invention. Accordingly, withdrawal of the Examiner's rejection under 35 U.S.C. §103 is respectfully solicited.

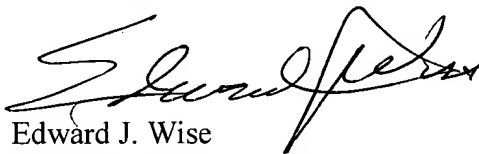
CONCLUSION

Accordingly, it is urged that the application is in condition for allowance, an indication of which is respectfully solicited. If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, Examiner is requested to call Applicants' attorney at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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